

## **REMARKS**

Entry of the amendment is respectfully requested. No new matter has been added.

Reconsideration is respectfully requested. The Examiner's comments are appreciated.

### **Application Status**

Claims 2-39 are pending. Claims 2, 3, 35, 36, 38, and 39 are independent.

Claims 12-14, 18-22, and 25-34 were indicated allowable if rewritten as independent.

Claims 3 and 24 were rejected under 35 U.S.C. § 112, second paragraph.

Claims 3-11, 15-17, 23-24, and 35-39 were rejected under 35 U.S.C. § 103(a) over Furuki (US 6,000,689) in view of Geib (US 5,207,788) and further in view of Graef (US D444,803).

Independent claim 2, being neither objected to nor rejected, must be presumed allowed.

This assessment also agrees with the Office's previous statement (in the Office Action dated September 9, 2005) that claim 2 would be allowable if made independent. Claim 23 depends on claim 2 and is thus allowable therewith.

### **The 35 U.S.C. § 112, second paragraph, rejections**

The Action states that it is understood that in claim 3 the language to "an arcuate projecting surface" is the same as the language to "the projecting surface". Nevertheless, the Office requests that "the arcuate projecting surface" be used.

In accordance with the Office's request, claims 3 and 24 have been amended. The amendment to claim 3 is for cosmetic purposes only. The merits of claim 3 have not been changed. Applicants respectfully submit that claims 3 and 24 are not indefinite and that the 35 U.S.C. § 112, second paragraph rejection should be withdrawn.

## **The 35 U.S.C. § 103(a) rejections**

### **Exemplary embodiment review**

To facilitate understanding by the Office, an exemplary embodiment will be reviewed. A picking disk (218) has a low friction arcuate projecting portion (258) extending radially outward (projecting) beyond a transversely adjacent high friction arcuate segment (228) (e.g., page 29, lines 5-12; page 32, lines 11-18; and Figures 18-21). Although not numbered in Figure 18, the surface of the projecting portion (258) is shown located next to and radially outward beyond the (lower part of the) high friction segment (228) (as also shown in Figure 19). As shown, the low friction portion (258) also circumferentially extends along only a portion of the length of the high friction segment (228).

### **The references**

#### **Furuki**

Furuki is directed to a copy machine, and is non analogous art. Furuki does not relate to an automated banking machine. Nor is there any evidence of record that Furuki's apparatus can pick notes. The record lacks evidence that the alleged picking member (3) in Furuki can both pick paper sheets (1) and pick automated banking machine notes. The Office hasn't even shown evidence of any picking member that can pick both paper sheet s and notes. As is well known, sheet paper and notes comprise different dimensions, constituents, and surface texture.

Furthermore, as acknowledged by the Office, the smooth outer surface of the alleged picking member (3) in Furuki is constant. The Action relies on Furuki at col. 1, line 29 for alleging that this constant surface is "a high friction surface". Applicants traverse the allegation. Furuki does not mention or discuss use of any "high friction" surface. Rather, the relied upon

section in Furuki (col. 1, lines 28-35) indicates that Furuki's sheet picking is based on the rollers (3, 4) having different torque settings.

### **Geib**

As previously discussed (in Applicants' response filed December 7, 2005), in Geib the alleged high friction arcuate segment (13) is on a drum roller (12), not Geib's picker roller (14) (col. 9, lines 38-44). Like the surface of the alleged picking member (3) in Furuki, Geib's picker roller (14) also has a smooth outer surface.

### **Graef**

Graef is a design patent. It is to an ornamental design and has no disclosed functional benefits. It is unclear how a non functional ornamental design can be used to render a functional apparatus obvious. Furthermore, except for the feed wheel tread design shown, all features attributed to Graef by the Office are pure speculation. For example, where does Graef specifically teach "greater frictional contact at the center area of the segment" and "a section of high friction surrounded by smooth area at the peripheral edges" as alleged by the Office (e.g., at Action page 5)? No material properties of the ornamental design are disclosed or suggested by the design patent. No areas can be identified as high friction or low friction as no material properties are disclosed or suggested. It follows that the rejections are improperly based on speculation instead of the required concrete evidence of record. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

### **Review of the Furuki, Geib, and Graef teachings**

In review, Furuki is non analogous art. Both Furuki and Geib teach that pick rollers have a smooth outer surface. Graef shows a non functional design for a feed wheel. As a result, the combined references at best teach a pick roller having a smooth outer surface.

### **Claim 3**

The combined references do not teach or suggest an arcuate projecting surface that is adjacent to, transversely disposed from, and extends radially outward beyond the high friction arcuate segment. If none of the references have a surface that projects outward further than the high friction segment (which is the situation), then neither can the combination of references produce the feature. The Office has not established a *prima facie* case of obviousness.

### **Claim 35**

Again, the combined references do not teach or suggest a section of a disk's outer surface having both low friction and high friction arcuate surfaces, where the low friction arcuate surface extends radially outward further than the high friction arcuate surface.

### **Claim 36**

The combined references do not teach or suggest an arcuate projecting surface that is adjacent to, transversely disposed from, and extends along only a portion of the high friction surface.

### **Claim 38**

Again, the combined references do not teach or suggest an arcuate projecting surface that is adjacent to, transversely disposed from, and extends radially outward beyond the high friction arcuate segment.

### **Claim 39**

Again, the combined references do not teach or suggest a section of a disk's outer surface having both low friction and high friction arcuate surfaces, where the low friction arcuate surface extends along only a portion of the high friction arcuate surface.

### **The Dependent Claims**

Each of the dependent claims depends directly or indirectly from an independent claim. Thus, it is asserted that the dependent claims are allowable on at least the same basis. Furthermore, each of the dependent claims additionally recites specific features and relationships that patentably distinguish the claimed invention over the applied art. The references do not teach or suggest the features and relationships that are specifically recited in the dependent claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features and relationships.

### **Conclusion**

Applicants respectfully submit that this application is in condition for allowance.

The undersigned is willing to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



Ralph E. Jocke      Reg. No. 31,029  
WALKER & JOCKE  
231 South Broadway  
Medina, Ohio 44256  
(330) 721-0000